

Appl. No. 08/879,070  
Amd dated January 2, 2004  
Reply to Office Action of July 1, 2003

### REMARKS

This amendment is responsive to the Office Action dated July 1, 2003. Claims 1-10 are pending.

#### Claim Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim(s) 1, 2 and 8-10 under 35 U.S.C. 103(a) as being unpatentable over DWORKIN (US 4,992,940) in view of "Sales-force automation comes of age" (referred to as SFA by the Examiner), JOSEPH (US 5,878,401) and BENNETT ET AL. (US 4,591,983). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

With reference to independent claims 1 and 8-10, for example, the applied references, alone or in combination, lack any teaching that would have suggested identifying one or more alternate products that correspond to a buildable product when a product that exactly corresponds to the requested product is not found.

It is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.<sup>1</sup> In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention.<sup>2</sup> A prima facie case of obviousness is established only when this burden is met.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.<sup>3</sup> Specifically, the Federal Circuit stated: "[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority."<sup>4</sup> This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.<sup>5</sup> Deficiencies in the evidentiary record cannot

<sup>1</sup> *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

<sup>2</sup> *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

<sup>3</sup> *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

<sup>4</sup> *Id.* at 1434.

<sup>5</sup> *Id.*

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be cured by general conclusions such as "general knowledge" or "common sense."<sup>6</sup> Accordingly, the Examiner cannot rely on unsupported statements to close holes in the evidentiary record.<sup>7</sup> Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant's dependent claims, the claims should be allowed.

The Examiner on page 3 of the most recent Office Action dated July 1, 2003 attempts to suggest that the combination of the applied references teach or suggest the limitations in the independent claims of identifying one or more alternate products that correspond to a buildable product when a product that exactly corresponds to the requested product is not found by arguing as follows:

"The SFA reference discloses a software product called GM PROSPEC that was used to configure and price vehicles (page 1, lines 36-42). The reference discloses that product configurator has virtually eliminated the factory reject rate that was associated with manual orders (page 1, lines 27-42). SFA further discloses the factory reject rate represented orders which were ultimately rejected because they were unbuildable. At the very least, SFA suggests that the product configurator called GM PROSPEC checks to see if the product is buildable. Furthermore, SFA discloses systems that perform next-best alternate processes (page 3, lines 24-27). At the very least, SFA suggests that the systems on the market have a process for determining alternate configured products (i.e. next best alternatives)." (see July 1, 2003 Office Action at p. 3, emphasis added).

The Examiner, in making his obvious rejection as argued above, cites his incorrect interpretation of the SFA reference for the limitations requiring configuration systems as recited within the claims check to see if a requested product is buildable. This argument is the ONLY TEACHING OR SUGGESTION within the applied references as set forth by the Examiner that addresses these limitations recited within the independent claims.

In making this argument, the Examiner makes the assumption that use of the GM PROSPEC configuration system disclosed within the SFA reference must check to see if configurable products are in fact buildable because the use of the disclosed product configurator "has virtually eliminated the factory rejection rate that was associated with manual orders." This

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<sup>6</sup> *Id.*

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assumption further is based upon a suggestion that some of the factory reject rate was caused by construction of unbuildable products. This assumption is not supported by the reference, even assuming that the Examiner has accurately described the teachings within the SFA reference. If the GM PROSPEC product configurator in fact tested to see if a requested product configuration was buildable, then one would expect the factory reject rate to drop to no errors or rejected orders as no product would be ordered using the GM PROSPEC product configurator that was not buildable. However, the SFA reference suggests that the factory reject rate dropped to VIRTUALLY ZERO – a suggestion that some factory orders were still being rejected. From this observation, one skilled in the art reading the SFA reference has no idea whether the GM PROSPEC configurator in fact tests whether a requested product is buildable because no such teaching or suggestion is actual within the reference. The observation that the factory reject rate dropped with use of the GM PROSPEC configurator may in fact be a result of the rejection in errors made from manually configuring products even if the configurator does not check to see if a selected product is buildable. As such, the independent claims are patentable over the prior art of record at least for this reason.

Furthermore, the Examiner has also identified no teaching in the prior art of a motivation to combine the teaching of all four of the applied references. Specifically, the Examiner has identified no motivation found within the prior art that teaches the modification of the product configuration system of DWORKIN, SFA, JOSEPH and BENNETT using all of the elements relied upon from other references. The Examiner has failed to explain why one of ordinary skill in the art would have looked to the all four of the applied references in combination for modification of the product configuration system of DWORKIN.

In attempting to cobble together an obvious rejection, the Examiner has cited four references that the Examiner asserts teaches or suggests all of the recited limitations. Even though the Applicants disagree within this assertion, the Examiner would not be correct in asserting that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine all four references together to obtain the claimed invention without use of the Applicants' own disclosure as a roadmap for such a combination. The

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<sup>7</sup> *Id.*

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Examiner begins his rejection using DWORKIN and then adding the teachings from SFA to address one or more acknowledged deficiencies. The Examiner then adds JOSEPH to address another deficiency followed by the addition of BENNETT to address further deficiencies.

The first of these motivations cited by the Examiner relates to the addition of product configuration constrains to the configuration process "in order to permit salespeople to configure products to suit the buyers' needs in an efficient manner and maximize the salesperson's time with customer thereby increasing profitability." See Office Action dated July 1, 2003 at page 7. The second of these motivations cited by the Examiner relates to the addition of JOSEPH "for the motivation of permitting customers an alternative to out of stock product selections to avoid customer dissatisfaction." See Office Action dated July 1, 2003 at page 8. The final of these motivations cited by the Examiner relates to the addition of BENNETT "in order to fill a customer needs in an efficient manner by flexibly assembling a product to match a customer's needs." See Office Action dated July 1, 2003 at pages 9-10.

The Court of Appeals for the Federal Circuit has made clear that motivation to combine references must be found in the prior art, and that it is impermissible hindsight for the Examiner to use the motivation stated in Applicant's own disclosure as a blueprint to reconstruct the claimed invention from the prior art.<sup>8</sup>

It is improper to point to teachings of motivation contained within Applicants' own disclosure.<sup>9</sup> Moreover, it is insufficient to merely pull such motivation out of thin air. Rather, the Examiner's rejection must be based on substantial evidence in the record demonstrated that the motivation for making the claimed invention resides in the prior art.<sup>10</sup>

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify DWORKIN in view of the combination of SFA, JOESPH and BENNETT is unsupported by any substantial evidence in the record. The Examiner's cited motivation as noted above is merely conclusory and does not address the need to combine all of the references

<sup>8</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

<sup>9</sup> *In re Oetiker*, 24 USPQ2d at 1445.

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together within a single system. The only reason the Examiner undertook the combination of these four references is because of the Applicants' own disclosure setting forth advantages of creating a system recited within the claims. The various motivations set forth by the Examiner are not related in any manner to accomplish a common goal or purpose. As such, the Examiner has failed to provide a motivation as to why the addition of all of the teaching asserted to be present in the applied references would not be obvious to one skilled in the art at the time the invention is made.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's independent claims 1 and 8-10 under 35 U.S.C. 103(a). Withdrawal of this rejection is respectfully requested.

Claims 2-7 depend from independent claim 1 and all recite addition limitations that further distinguish these claims from the prior art of record. As such, claims 2-7 are also patentable for at least the reasons set forth above. Withdrawal of this rejection is therefore respectfully requested.

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<sup>10</sup> *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); *In re Chu*, 36 USPQ2d at 1094.

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### CONCLUSION

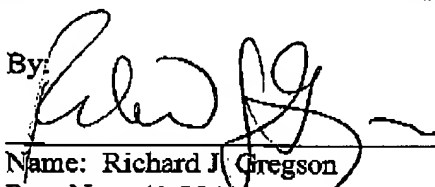
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. Because the Applicants and the Examiner have disagreed on several occasions, the Examiner is respectfully invited to telephone the below-signed attorney to discuss this application prior to assertion of an additional rejection in this matter in an attempt to further prosecution of this application.

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2 Jan 2004

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